

Appln No. 09/693,219
Amdt. Dated November 24, 2005
Response to Final Office Action
Of October 20, 2005

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REMARKS/ARGUMENTS

Claims

The Examiner rejected claims 1, 6-7, 15-18 and 22-30. By this amendment claims 1, 7, 15, 18 and 22 have been amended. Therefore claims 1, 6-7, 15-18, and 22-30 remain pending in the application.

Claim Rejections – 35 USC §112

Claims 1 and 18 were rejected under 35 USC 112, second paragraph for failing to point out and distinctly claiming the subject matter of the invention.

The applicant acknowledges the Examiner's rejection and has accordingly amended claims 1 and 18 to clearly define the present invention. In particular the applicant has amended the claims to clearly define the antecedences associated with "visible markings" and "invisible coded data". The applicant respectfully submits that the amended claims are clear and distinctly claim the subject matter of the present invention.

Claim Rejections – 35 USC §103

Claims 1, 6-7, 15-18 and 22-30 were rejected under 35 USC 103(a) as being unpatentable over Tabata et al (US 6537324), and in view of Dymetman et al (US 6330976), and further in view of Kessler (US 20010010195). The rejection is respectfully traversed.

The Examiner asserted that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Tabata to include a printer and/or facsimile apparatus as taught by Dymetman, for reading a document that includes markings with digital inks and markings without digital inks, and duplicate only markings with digital inks because "using pen-like pointer 502 (fig. 1) for writing digital inks coded data and/or any ordinary writing surface and only transmits (i.e. faxing) markings with digital ink (i.e. messages written with pen-like pointer) rather than all the contains within a document; therefore, reducing transmission time." However, the Applicants assert that the above complex reasoning of the Examiner is formed entirely through an analysis of the present teachings of the Applicant, and that there is no suggestion or motivation in Tabata, Dymetman or Kessler for transmitting markings associated with digital ink and not transmitting markings not associated with digital ink so as to reduce a facsimile transmission time.

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The Applicants respectfully remind the Examiner that any motivation to combine prior art documents must come from the prior art documents themselves, and not from the teachings of the Applicant. See for example MPEP 2143.01(III):

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references)."

The present invention enables the creation of a "pristine digital copy" that does not reproduce "unwanted artifacts such as creases and dirt." See the specification as originally filed at page 22, line 29 to page 23, line 13. The prior art cited by the Examiner includes no suggestions or motivations to make such pristine digital copies. Further, the reasoning given by the Examiner for combining the cited references—i.e., reducing facsimile transmission time—is not only unrelated to the stated function of the presently claimed invention—i.e., creating "pristine digital copies"—but the reasoning of the Examiner is not even suggested in the cited documents and appears to be based on a possible alternative function of the present invention that is derived only from the disclosure in the present application. Thus, as in *In Re Mills*, here there is no "suggestion or motivation in the references" cited by the Examiner that the disclosure of Dymetman "may be capable of being modified to run the way the [present] apparatus is claimed."

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The applicants again thank the Examiner for his careful consideration of the present application and his previous efforts to thoroughly understand the complexities of the present invention, and for his carefully considered suggestions for preferred claim language. The presently amended claims are now clear and definite and distinguishable over the prior art of Tabata et al, Dymetman et al and Kessler cited by the Examiner. Therefore it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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